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10/713,820

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Thomas W. Davison

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MINNEAPOLIS, MN 55403-2420

EXAMINER

NGUYEN, VI X

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* THOMAS W. DAVISON, TIMOTHY E. TAYLOR,  
and ADAM SHER

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Application 10/713,820  
Technology Center 3700

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Mailed: December 15, 2008

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*Before* HARRY HORTON, *Discipline Team Paralegal*.  
HORTON, *Discipline Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on October 15, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

APPEAL BRIEF, CLAIMS APPENDIX

A review of the Appeal Brief filed October 18, 2007 reveals that claim(s) 44 and 50 in the Claims appendix of the Appeal Brief are not consistent as amended in the last entered amendment filed on December 27, 2006. The copy of the claims should be in proper format and should not include any markings such as brackets or underlining except for claims in a reissue application in accordance with 37 C.F.R. § 41.37(c)(1)(viii) (2007). Furthermore, the Claims Appendix cannot assume entry of After Final Submissions for which an Advisory Action (or other Office communication) has not advised of entry. *See also Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8<sup>th</sup> ed. Rev. 6, Sept 2007) for details.

Specifically, claims 44 and 50 as provided in the Brief's Claims Appendix, read: (Claim 44) "an arcuate guide having an elongate length, a first end and a second end along which a portion of the elongate body is moveable from its contracted condition to its expanded condition, the arcuate guide extending generally in the direction of expansion between the contracted and expanded conditions." (Claim 50) "a guiding mechanism comprising a curved elongate portion."

However, in the last entered Amendment dated December 27, 2006, claims 44 and 50 read: (Claim 44) "an arcuate guide having a first end and a second end along which a portion of the elongate body is moveable from its contracted condition to its expanded condition, the arcuate guide extending generally in the direction of expansion between the contracted and expanded conditions." (Claim 50) "a guiding mechanism comprising a curved portion." Appropriate correction of all claims provided in the Claims Appendix in proper format is required.

INFORMATION DISCLOSURE STATEMENT

Appellants filed an Information Disclosure Statements (IDS) dated October 05, 2007. *The Manual of Patent Examining Procedure* (MPEP) § 609 requires the Examiner to consider any IDS filed by Appellants if timely submitted. A written communication notifying Appellants of the Examiner's consideration of the above IDS is required.

### CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to consider the IDS filed October 5, 2007;
- 2) to notify Appellants of said consideration and have communication made of record in the instant IFW application;
- 3) to notify Appellants to submit a correction of the Claims Appendix of the Appeal Brief filed October 18, 2007; and
- 4) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

hh

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